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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,025	04/04/2001	Lung-Ji Chang	CNG-100D1	4500

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EXAMINER

FALK, ANNE MARIE

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 02/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/826,025	Applicant(s) CHANG, LUNG-JI	
	Examiner Anne-Marie Falk, Ph.D.	Art Unit 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 17-50 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_                      6) ☐ Other:

### DETAILED ACTION

The preliminary amendment filed May 21, 2001 (Paper No. 3) has been entered. Claims 1-16 have been cancelled. Claims 17-50 have been newly added.

Claims 17-50 are pending in the instant application.

#### *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 17-20, drawn to a tumor cell composition, classified in class 435, subclass 325.
- II. Claims 21-28, drawn to an expression vector, classified in class 435, subclass 320.1.
- III. Claims 29-50, drawn to a method for the treatment or prevention of cancer, classified in class 424, subclass 93.21.

The inventions are distinct, each from the other because of the following reasons: ,

Inventions I and II are patentably distinct because the inventions are drawn to distinct compositions. The tumor cell composition of the invention of Group I is chemically, biologically, structurally, and functionally distinct from the expression vector of the invention of Group II. Although the expression vector can be used to produce the tumor cell composition of the invention of Group I, it can also be used to transfect other cell types to produce recombinant protein in cells in culture. Thus, the composition of the invention of Group I is patentably distinct from the composition of the invention of Group II.

Inventions I and III are patentably distinct because the inventions are drawn to distinct methods and compositions. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product

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as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the tumor cell composition of the invention of Group I can be used for carrying out *in vitro* assays. Thus, the tumor cell composition of the invention of Group I is patentably distinct from the method for the treatment or prevention of cancer of the invention of Group III.

Inventions II and III are patentably distinct because the inventions are drawn to distinct methods and compositions. As pertains to Claims 29-42, Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the expression vector of the invention of Group II can be used to transfect other cell types to produce recombinant protein in cells in culture. As pertains to Claims 43-50, the expression vector of the invention of Group II is not required for and cannot be used to carry out the method of the invention of Group III. Thus, the expression vector of the invention of Group II is patentably distinct from the method for the treatment or prevention of cancer of the invention of Group III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the separate inventions are not coextensive, restriction for examination purposes as indicated is proper. Because the searches are not coextensive, a search and examination of all three inventions in a single patent application would constitute a serious burden on the Examiner.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Falk whose telephone number is (703) 306-9155. The examiner can normally be reached Monday through Thursday and alternate Fridays from 10:00 AM to 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst, William Phillips, whose telephone number is (703) 305-3482.

Anne-Marie Falk, Ph.D.

*Anne-Marie Falk*  
ANNE-MARIE FALK, PH.D  
PRIMARY EXAMINER